

REMARKS/ARGUMENTS

Claim 1 is pending in the present application. Claim 1 was amended; no claims were added or canceled. Reconsideration of the claims is respectfully requested.

Applicants wish to thank Examiner Najee-Ullah for participating in a telephone interview on June 16, 2008. Examiner Najee-Ullah further clarified the 102 rejection and his interpretation of the prior art and provided guidance regarding overcoming the prior art.

I. 35 U.S.C. § 102, Anticipation

The Examiner has rejected claim 1 under 35 U.S.C. § 102 as being anticipated by *Yaker*, U.S. Publication No. 2002/0090069 (hereinafter "*Yaker*"). This rejection is respectfully traversed.

The examiner states:

Regarding claim 1, *Yaker* discloses **a method for sending a notice that a user is away, the method comprising: determining email addresses of recipients to which email messages have been previously sent within a configurable time period to form a set of determined email addresses (pg. 2, par. [0026]), wherein the configurable time period is set by the user (pg. 2, par. [0022-0023]); responsive to the user sending an email message to a recipient, storing an email address for the recipient and a date of the email message in the set of determined email addresses, wherein email addresses stored in the set of determined email addresses are removable by the user (pg. 2, par. [0022-0023]); automatically removing the email address for the recipient from the set of determined email addresses if the date of the email message is older than a selected period of time (pg. 2, par. [0022-0023]), wherein the selected period of time is configurable to be the same or different for each stored email address stored in the set of determined email addresses (pg. 2, par. [0023]); responsive to receiving an email message having a same email address within set of determined email addresses, replying with a notification that the user is away (pg. 2, par. [0022-0023]), wherein the notification that the user is away is customizable by the user (pg. 2, par. [0025-0026]).**

Office Action dated May 9, 2008, pages 2-3 (emphasis in original).

A prior art reference anticipates the claimed invention under 35 U.S.C. § 102 only if every element of a claimed invention is identically shown in that single reference, arranged as they are in the claims. *In re Bond*, 910 F.2d 831, 832, 15 U.S.P.Q.2d 1566, 1567 (Fed. Cir. 1990). All limitations of the claimed invention must be considered when determining patentability. *In re Lowry*, 32 F.3d 1579, 1582, 32 U.S.P.Q.2d 1031, 1034 (Fed. Cir. 1994). Anticipation focuses on whether a claim reads on the product or process a prior art reference discloses, not on what the reference broadly teaches. *Kalman v. Kimberly-*

Clark Corp., 713 F.2d 760, 218 U.S.P.Q. 781 (Fed. Cir. 1983). In this case, each and every feature of the presently claimed invention is not identically shown in the cited reference, arranged as they are in the claims.

Amended independent claim 1 recites:

1. A method for selectively generating automatic notifications that a user is away, the method comprising:
 - responsive to receiving an email message at an email address of the user, determining whether an e-mail address of the sender of the email message is an email address in a set of determined email addresses comprising email addresses of recipients to which email messages have been previously sent within a configurable time that is uniquely associated with each email address in the set of determined email addresses, wherein the set of determined email addresses and a date associated with each email address in the set of determined email addresses is stored in a data structure, and wherein the date associated with each email address in the set of determined email addresses is a date an email message was sent to the associated email address from the email address of the user;
 - responsive to a determination that the email address of the sender is an email address in the set of determined email addresses, sending an away notification to the email address of the sender; and
 - responsive to a determination that the email address of the sender is not an email address in the list of determined email addresses, not sending an away notification to the email address of the sender.

In the telephone interview the Examiner explained his interpretation of paragraph [0026] of *Yaker* and how he believed that passage taught the features of “determining email addresses of recipients to which email messages have been previously sent by the user within a configurable time period to form a set of determined email addresses, wherein the configurable time period is set by the user,” “responsive to the user sending an email message to a recipient, storing an email address for the recipient and a date of the email message sent by the user in the set of determined email addresses, wherein email addresses stored in the set of determined email addresses are removable by the user,” and “automatically removing the email address for the recipient from the set of determined email addresses if the date of the email message is older than a selected period of time, wherein the selected period of time is set by the user, and wherein the selected period of time is configurable to be the same or different for each stored email address stored in the set of determined email addresses,” as recited in claim 1 before claim 1 was amended.”

Specifically, the Examiner explained that he felt the passage of paragraph [0026] “[a]lternatively or in addition, the email tool may interpret the incoming email message based on pre-determined criteria, such as but not limited to, the source of the email message (i.e., whether it be within the network or outside the user’s network) or key words found within the email message that serve to trigger a certain prepared response,” could be interpreted to teach the features of “determining email addresses of

recipients to which email messages have been previously sent within a configurable time period to form a set of determined email addresses, wherein the configurable time period is set by the user,” “responsive to the user sending an email message to a recipient, storing an email address for the recipient and a date of the email message in the set of determined email addresses, wherein email addresses stored in the set of determined email addresses are removable by the user,” and “automatically removing the email address for the recipient from the set of determined email addresses if the date of the email message is older than a selected period of time, wherein the selected period of time is set by the user, and wherein the selected period of time is configurable to be the same or different for each stored email address stored in the set of determined email addresses.” However, upon further consideration, Applicants respectfully disagree.

Claim 1 teaches that when an email message is received at the email address of the user, a determination is made as to whether the email address of the sender of the message is an email address of a set of determined email addresses. The set of email addresses are created based on the date an email message was sent from an email address of a user to the recipient being with a configurable time period. The configurable time period is uniquely associated with the email address of the recipient. If the email address of the sender is an email address of the set of determined email addresses, a notification that the user is away is sent to the sender of the incoming email message. If the email address of the sender is not an email address of the set of determined email addresses, no notification is sent to the sender of the incoming email message. Thus, notifications are only sent to senders to which the user has been actively communicating within a configurable time period. *Yaker* does not teach such a system. Rather, *Yaker* simply teaches that pre-determined criteria or keywords in the incoming email serve to trigger certain responses.

As stated in *Yaker*, the “pre-determined criteria” and the “keywords” used by the email tool are used for “interpreting incoming email messages.” (Emphasis added.) In contradistinction, claim 1 recites “a set of determined email addresses comprising email addresses of recipients to which email messages have been previously sent within a configurable time that is uniquely associated with each email address in the set of determined email addresses.” That is, the determined set of email addresses correspond to recipients to whom the user has sent an email message within a configurable time period. Therefore, even assuming *arguendo* that the pre-determined criteria and keywords of *Yaker*, which are used to trigger “a certain prepared response” could be construed as determining a set of email address, *Yaker* still fails to teach the feature of “a set of determined email addresses comprising email addresses of recipients to which email messages have been previously sent within a configurable time that is uniquely associated with each email address in the set of determined email addresses,” as the teachings of *Yaker* apply to incoming emails only.

Further, paragraph 26 of *Yaker* teaches that incoming email messages may receive different responses based on whether the sender of the message is “within the network or outside the user’s network.” However, whether a sender of a received email is within the recipient’s network or outside the recipient’s network is not the same as the feature of “a set of determined email addresses comprising email addresses of recipients to which email messages have been previously sent within a configurable time wherein the configurable time period is uniquely associated with each email address in the set of determined email addresses,” as recited in claim 1. Also, this determination of whether an email is in or out of a recipient’s network, as taught by *Yaker*, applies to incoming emails and is used to trigger certain replies, not to create a set of determined addresses.

Additionally, claim 1 recites “wherein the set of determined email addresses and a date associated with each email address is the set of determined email addresses is stored in a data structure, and wherein the date associated with each email address in the set of determined email addresses is a date an email message was sent to the associated email address from the email address of the user.” Nothing in *Yaker* teaches such a feature. Therefore, even assuming *arguendo* that the pre-determined criteria and keywords of *Yaker*, which are used to trigger “a certain prepared response” could be construed as a set of email addresses, *Yaker* still fails to teach the feature of “wherein the set of determined email addresses and a date associated with each email address is the set of determined email address is stored in a data structure, and wherein the date associated with each email address in the set of determined email addresses is a date an email message was sent to the associated email address from the email address of the user,” as the cited passage of *Yaker*, nor any other passage of *Yaker*, teaches that when an email is sent by the user, the email address of the recipient and the date the email message was sent is stored in a data structure as part of the set of determined email addresses.

Also, *Yaker* fails to teach the feature of “responsive to a determination that the email address of the sender is not an email address in the list of determined email addresses, not sending an away notification to the email address of the sender.” *Yaker* merely teaches that the reply sent to a particular sender of an email may vary based on keywords and whether the sender of the message is within the recipients network. However, nothing in *Yaker* teaches not sending a notification to sender, as recited in claim 1.

Therefore, for at least the reasons set forth above, Applicants submit that the *Yaker* reference fails to anticipate claim 1, as the *Yaker* reference fails to teach all the features of claim 1. Thus, Applicants submit that claim is in condition for allowance over the cited reference.

Therefore, the rejection of claim 1 under 35 U.S.C. § 102 has been overcome.

II. Conclusion

It is respectfully urged that the subject application is patentable over *Yaker* and is now in condition for allowance.

The Examiner is invited to call the undersigned at the below-listed telephone number if in the opinion of the Examiner such a telephone conference would expedite or aid the prosecution and examination of this application.

DATE: August 11, 2008

Respectfully submitted,

/Gerald H. Glanzman/

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